

### **REMARKS**

This Amendment is responsive to the Office Action dated August 16, 2005. Applicant has amended claim 25 and 41 and added claims 45 and 46. Upon entry of this amendment, claims 1-46 are pending.

### **Claim Rejection Under 35 U.S.C. § 103**

#### ***Claims 1-5, 9, 12, 14-24, 28-38 and 41-44***

In the Office Action, the Examiner rejected claims 1-5, 9, 12, 14-24, 28-38 and 41-44 under 35 U.S.C. 103(a) as being unpatentable over Brochure from 3M™ Optical System Div (75-0500-5195-4(2002)) ("3M Brochure") in view of Ogido Haruo (JP91574600) ("Haruo"). Applicant respectfully traverses the rejection. The applied references fail to disclose or suggest the inventions defined by Applicant's claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

For example, both 3M Brochure and Haruo, either singularly or in combination, fail to teach or suggest a system comprising an adhesive hinge to adhere to a housing of a display screen and a first side of the display screen filter such that the first side of the display screen filter is attached to the housing in a hinged manner, as recited by Applicant's independent claims 1, 21, 32 and 41.

The Examiner asserted that 3M Brochure teaches a display screen filter that adheres to a housing of a display screen (FIG. A of 3M Brochure) and a plurality of clasps to adhere to the housing and hold a second side of the display screen filter adjacent the housing without adhering to the display screen filter (FIG. B of 3M Brochure). However, 3M Brochure discloses two different techniques for attaching a display screen filter adjacent a display screen. 3M Brochure does not describe a single technique that both adheres a display screen filter to a housing of a display screen and holds the display screen filter adjacent the housing without adhering to the display screen filter.

The Examiner correctly acknowledged that the 3M Brochure reference fails to teach an adhesive hinge being adhered to the housing and a first side of the display screen filter.

However, the Examiner asserted that Haruo teaches an adhesive hinge tape for firmly jointing

two objects together. The Examiner further stated that it would have been obvious to one of ordinary skill in the art to modify the device of 3M Brochure with the adhesive hinge tape taught by Haruo for movable attachment to the display screen and easy access to the display screen surface for cleaning.

On the contrary, the 3M Brochure reference fails to teach or suggest an *adhesive hinge* as another display screen filter attachment technique. Furthermore, Haruo fails to teach or suggest attaching a *display screen filter* to a housing of a *display screen* in a hinged manner with an adhesive hinge. Haruo merely describes an adhesive tape that includes bending lines such that two objects may be firmly jointed together. The Haruo reference fails to disclose a display screen or a display screen filter to be attached to the display screen. Neither Haruo nor 3M Brochure make any suggestion that would lead a person of ordinary skill in the art to adhere a display screen filter to a housing of a display screen in a hinged manner with an adhesive hinge.

It is well established that the Examiner bears the burden of establishing a prima facie case of obviousness.<sup>1</sup> In doing so, the Examiner must determine whether the prior art provides a “teaching or suggestion to one of ordinary skill in the art to make the changes that would produce” the claimed invention.<sup>2</sup> A prima facie case of obviousness is established only when this burden is met.

The Court of Appeals for the Federal Circuit has specifically addressed the evidentiary standard required to uphold an obviousness rejection.<sup>3</sup> Specifically, the Federal Circuit stated: “[the] factual question of motivation is material to patentability, and (can) not be resolved on subjective belief and unknown authority.<sup>4</sup> This finding must be based upon substantial evidence, and not subjective musings or conjecture by the Examiner.<sup>5</sup> Unless the Examiner can establish an evidentiary record based on concrete prior art references that establish that it would have been obvious to a person with ordinary skill in the art to incorporate the features of Applicant’s claims, the claims should be allowed.

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<sup>1</sup> *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

<sup>2</sup> *In re Chu*, 36 USPQ2d 1089, 1094 (Fed. Cir. 1995).

<sup>3</sup> *In re Lee*, 61 USPQ2d 1430, (CAFC 2002).

<sup>4</sup> *Id.* at 1434.

<sup>5</sup> *Id.*

The conclusion of obviousness advanced by the Examiner relies on a motivation plucked directly from Applicant's own disclosure, rather than the prior art. Indeed, the Examiner cited no prior art teaching as the source for the motivation. Specifically, the Examiner has identified no motivation found within the prior art that teaches the modification of the display screen filter attachment systems of 3M Brochure using the adhesive tape of Haruo. Haruo describes the adhesive tape as jointing two objects together, and 3M Brochure describes a display screen filter attached adjacent a display screen. The Examiner has failed to explain why one of ordinary skill in the art would have looked to the adhesive tape of Haruo for modification of the attachment system of 3M Brochure for attachment of a display screen filter to a display screen.

It is improper to point to teachings of motivation contained within Applicants' own disclosure.<sup>6</sup> Moreover, it is insufficient to merely pull such motivation out of thin air. Rather, the Examiner's rejection must be based on substantial evidence in the record demonstrated that the motivation for making the claimed invention resides in the prior art.<sup>7</sup> In summary, the Examiner's conclusion of obviousness, and particularly the cited motivation to modify the display screen filter attachment system of 3M Brochure in view of the adhesive tape of Haruo, is unsupported by any substantial evidence in the record.

Moreover, even if the teachings of 3M Brochure and Haruo were combined, it would not result in the Applicant's invention as claimed. Including an adhesive tape used to firmly joint objects together, as described by Haruo, with the attachment techniques described by 3M Brochure would merely create an additional technique for attaching a display screen filter to a housing of a display screen. Therefore, the combined references would simply teach three separate techniques for adhering a display screen filter to a housing of a display screen. The teaching of 3M Brochure as modified by Haruo would not disclose the system of an adhesive hinge to attach a display screen filter to a housing of a display screen in a hinged manner, and a clasp to hold the display screen filter adjacent the housing without adhering to the display screen filter, as recited by Applicant's claims 1, 21, 32 and 41 as amended.

In a similar manner, the cited references fail to disclose the features required by Applicant's dependent claims 2-20, 22-31, 33-40 and 42-44. For example, claims 3, 22 and 36

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<sup>6</sup> *In re Oetiker*, 24 USPQ2d at 1445.

<sup>7</sup> *In re Lee*, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002); *In re Chu*, 36 USPQ2d at 1094.

recite that the clasp removably holds the display screen filter adjacent the housing such that the display screen filter can be removed from the clasp and moved in an arc about the adhesive hinge. As described above, neither 3M Brochure nor Haruo, either singularly or in combination, disclose an adhesive hinge adhered to a housing of a display screen and a display screen filter to attach the display screen filter to the housing in a hinged manner. Furthermore, the cited references fail to describe the display screen filter capable of being removed from a clasp and moved in an *arc about the adhesive hinge*.

In addition, claims 5, 24 and 38 recite the clasp comprising a *first member* including an adhesive to adhere to the housing and a *second member* to hold the second side of the display screen filter adjacent the housing without adhering to the display screen filter, wherein the second member is attached to the first member. Haruo makes no mention of any type of clasp, let alone a clasp that includes a first member and a second member that holds a display screen filter adjacent a housing of a display. 3M Brochure also fails to disclose a clasp with a first member adhered to the housing and a second member that holds the display screen filter adjacent the housing. As clearly illustrated in FIGS. A and B of the 3M Brochure reference, the adhesive tabs or clasps do not comprise first and second members. 3M Brochure fails to suggest that the disclosed adhesive tabs or clasps include a first member and a second member.

Furthermore, claims 15, 34 and 42 recite the adhesive hinge including a crease substantially along the major axis of the adhesive hinge corresponds to a *bezel* of the housing. As described above, Haruo fails to even mention a display screen, let alone a bezel in the housing of the display screen. 3M Brochure also fails to mention a bezel of the housing of the display screen. Therefore, 3M Brochure in view of Haruo certainly does not describe an adhesive hinge with a crease that corresponds to the *bezel* of the display screen housing.

***Claims 7, 10, 11, 26 and 40***

In the Office Action, the Examiner rejected claims 7, 10, 11, 26 and 40 under 35 U.S.C. 103(a) as being unpatentable over 3M Brochure in view of Haruo. Applicant respectfully traverses the rejection. The applied references fail to disclose or suggest the inventions defined by Applicant's claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

Claims 7, 26 and 40 recite that the clasp comprises a *memory material* that distorts from an original shape to release the display screen filter and returns to the original shape to hold the display screen filter adjacent the housing. Claim 10 recites that the adhesive hinge comprises a rigid material wherein the rigid substrate comprises a metal, and claim 11 recites that the rigid material comprises a plastic.

The Examiner stated that it would have been obvious to one having ordinary skill in the art to select a memory material for the clasps and a metal or a plastic for the rigid substrate of the adhesive hinge. The Examiner further stated that it has been held to be within the general skill of a worker in the art to select a material on the basis of its suitability for the intended use.

Unfortunately, 3M Brochure and Haruo lack any teaching that would have suggested forming a clasp from a *memory material* to hold a display screen filter adjacent a housing of a display screen. The references also fail to suggest forming the adhesive hinge out of a rigid *metal or plastic*. Furthermore, both 3M Brochure and Haruo, either singularly or in combination, fail to describe a system that includes an adhesive hinge to adhere to a display screen filter and a housing of a display screen to attach the display screen filter to the display screen in a hinged manner, as recited by Applicant's independent claims 1, 21 and 32 from which claims 7, 26 and 40 depend.

In order to support a prima facie case of obviousness, three basic criteria must be met. *See* MPEP 706.02(j). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *Id.*

The conclusion of obviousness advanced by the Examiner for the rejections of claims 7, 10, 11, 26 and 40 is clearly improper insofar as the Examiner has cited no evidence to support the Examiner's conclusion. In particular, the Examiner has failed to meet any of the three requirements of MPEP 706.02(j).

With respect to claims 7, 10, 11, 26 and 40, not only has the Examiner failed to cite any prior art references that teach the claim limitations, but the Examiner has relied on a motivation plucked directly from Applicant's own disclosure, which is impermissible. Indeed, the Examiner

cited no prior art teaching as the source for the motivation. Accordingly, the rejections of claims 7, 10, 11, 26 and 40 are improper and must be withdrawn.

***Claim 13***

In the Office Action, the Examiner rejected claim 13 under 35 U.S.C. 103(a) as being unpatentable over 3M Brochure in view of Haruo. Applicant respectfully traverses the rejection. The applied references fail to disclose or suggest the inventions defined by Applicant's claim, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

Claim 13 recites that the adhesive hinge includes a source identifier. The Examiner asserted that it would have obvious to one of ordinary skill in the art that an adhesive hinge may include a source identifier. The Examiner then took an Official Notice that the adhesive hinge may include a source identifier. In paragraph [0037], Applicant describes the adhesive hinge having markings that may include a source identifier, e.g., a trademark, of the manufacturer of the adhesive hinge. However, 3M Brochure fails to make any mention of an adhesive hinge. In addition, Haruo fails to describe any markings printed on the disclosed adhesive tape, let alone a source identifier.

Again, the conclusion of obviousness advanced by the Examiner relies on a motivation plucked directly from Applicant's own disclosure, rather than the prior art. Indeed, the Examiner cited no prior art teaching as the source for the motivation. In the Office Action, the Examiner stated that supportive documents of the Examiner's Official Notice will be provided upon request. Applicant requests such documents that purportedly teach an adhesive hinge that includes a source identifier, such as a trademark.

For at least these reasons, the Examiner has failed to establish a prima facie case for non-patentability of Applicant's claims 1-5, 7, 9-24, 26, 28-38 and 40-44 under 35 U.S.C. 103(a). Withdrawal of this rejection is requested.

**Allowable Subject Matter**

In the Office Action, the Examiner objected to claims 6, 8, 25, 27 and 39 as including subject matter that would be allowable if rewritten in independent form. For at least the reasons given above, Applicant's independent claims 1, 21 and 32 are in condition for allowance. Consequently, dependent claims 6, 8, 25, 27 and 39 are also in condition for allowance.

In this amendment, Applicant has added claims 45 and 46. Claim 45 recites all the features of independent claim 1 as well as all the features of dependent claim 6 and intervening claim 5 on which claim 6 depends. Furthermore, claim 46 recites all the features of independent claim 1 as well as all the features of dependent claim 8. Therefore, claims 45 and 46 are in condition for allowance.

**Conclusion**

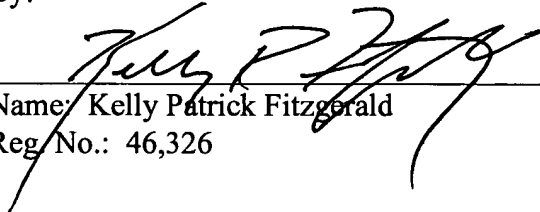
All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed agent to discuss this application.

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SHUMAKER & SIEFFERT, P.A.  
8425 Seasons Parkway, Suite 105  
St. Paul, Minnesota 55125  
Telephone: 651.735.1100  
Facsimile: 651.735.1102

By:

  
Name: Kelly Patrick Fitzgerald  
Reg. No.: 46,326